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09/867,363	05/29/2001	Chidambaram Krishnan	010094	5659

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Qualcomm Incorporated
Patents Department
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EXAMINER

MOORTHY, ARAVIND K

ART UNIT PAPER NUMBER

2131

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,363

Applicant(s)

KRISHNAN ET AL.

Examiner

Aravind K. Moorthy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the amendment filed on 24 February 2005.
2. Claims 1-72 are pending in the application.
3. Claims 1-72 have been rejected.

Response to Arguments

4. Applicant's arguments with respect to claims 1-72 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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5. Claims 1-5, 7-9, 11-13, 16-21, 23-25, 27-29, 32-37, 39-41, 43-45, 48-53, 56-61, 64-69 and 72 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolev et al U.S. Patent No. 6,125,283.

As to claims 1, 17 and 33, Kolev et al discloses a method for controlling power to a subscriber identity module (SIM) in a wireless communication device (WCD), the method comprising:

supplying power to the SIM when a request is pending for service by the SIM [column 9, lines 6-53];

supplying power to the SIM when a software module running on the WCD requests maintenance of power to the SIM [column 9, lines 6-53]; and

terminating power to the SIM when no request is pending for service by the SIM and no software module running on the WCD requests maintenance of power to the SIM [column 9, lines 6-53].

As to claims 2, 18 and 34, Kolev et al discloses re-initiating supply of power to the SIM following termination of power to the SIM when a request from the WCD is pending for service by the SIM [column 9, lines 6-53].

As to claims 3, 19 and 35, Kolev et al discloses determining whether a request from the WCD is pending for service by the SIM by inspecting a request queue associated with the SIM [column 10, lines 26-50].

As to claims 4, 20 and 36, Kolev et al discloses re-initiating supply of power to the SIM when a software module running on the WCD requests supply of power to the SIM [column 9, lines 6-53].

As to claims 5, 21 and 37, Kolev et al discloses determining whether a software module running on the WCD requests supply of power to the SIM by polling any of a plurality of software modules running on the WCD [column 9, lines 6-53].

As to claims 7, 23 and 39, Kolev et al discloses supplying power to the SIM includes maintaining power to the SIM [column 9, lines 6-53].

As to claims 8, 24 and 40, Kolev et al discloses that the SIM includes an interface circuit that interfaces with the WCD, and terminating power to the SIM includes terminating power to the interface circuit [column 9, lines 6-53].

As to claims 9, 25 and 41, Kolev et al discloses that the SIM includes a power supply line coupled to the WCD, and terminating power to the SIM includes terminating power to the power supply line [column 9, lines 6-53].

As to claims 11 and 27, Kolev et al discloses the method further comprising:

storing a user access code associated with the SIM in a memory associated with the WCD [column 8, lines 40-59];

retrieving the user access code from the memory when power is supplied to the SIM following the termination of power to the SIM [column 8, lines 40-59]; and

using the retrieved user access code in a security authorization process in the WCD to authorize use of secure features of the SIM [column 8, lines 40-59].

As to claims 12, 28 and 44, Kolev et al discloses storing the user access code includes storing the user access code upon the termination of power to the SIM [column 8, lines 40-59].

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As to claims 13, 29, 45, 53, 61 and 69, Kolev et al discloses that the SIM is one of a removable user identification module (R-UIM) [column 6, lines 18-41] and a GSM SIM [column 5 line 65 to column 6 line 17], and the user access code is a card holder verification (CHV) code [column 8, lines 40-59].

As to claims 16, 32, 48, 56, 64 and 72, Kolev et al discloses that the WCD is one of a cellular radiotelephone, a satellite radiotelephone, a PCMCIA card, and a PDA that communicates according to one of the CDMA standard, the GSM standard, and the WCDMA standard [column 5 line 65 to column 6 line 17].

As to claim 43, Kolev et al discloses the instructions cause the processor to:

store a user access code associated with the SIM in a memory associated with the WCD [column 8, lines 40-59];

retrieve the user access code from the memory when power is supplied to the SIM following the termination of power to the SIM [column 8, lines 40-59];
and

use the retrieved user access code in a security authorization process in the WCD to authorize use of the WCD [column 8, lines 40-59].

As to claims 49, 57 and 65, Kolev et al discloses a method comprising:

storing a user access code associated with a subscriber identity module (SIM) in a memory associated with a wireless communication device (WCD) [column 8, lines 40-59];

retrieving the user access code from the memory when power is resupplied to the SIM [column 8, lines 40-59]; and

using the retrieved user access code in a security authorization process in the WCD to authorize use of secure features of the SIM [column 8, lines 40-59].

As to claims 50, 58 and 66, Kolev et al discloses the method further comprising:

terminating power to the SIM when no request from the WCD is pending for service by the SIM and no software module running on the WCD requests supply of power to the SIM [column 8 line 6 to column 9 line 61]; and

terminating power to the SIM when power to the WCD is terminated [column 8 line 6 to column 9 line 61].

As to claims 51, 59 and 67, Kolev et al discloses the method further comprising:

retrieving and using the user access code when power is resupplied to the SIM following termination when no request from the WCD is pending for service by the SIM and no software module running on the WCD requests supply of power to the SIM [column 8 line 6 to column 9 line 61]; and

accepting and using user input as the user access code when power is resupplied to the SIM following termination when power to the WCD is terminated [column 8 line 6 to column 9 line 61].

As to claims 52, 60 and 68, Kolev et al discloses storing the user access code includes storing the user access code when power to the SIM is terminated [column 8 line 6 to column 9 line 61].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 22 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolev et al U.S. Patent No. 6,125,283 as applied to claims 1, 17 and 33 above, and further in view of Deschepper et al U.S. Patent No. 6,741,848 B2.

As to claims 6, 22 and 38, Kolev et al does not teach asserting respective bits in a data structure when corresponding software modules running on the WCD request supply of power to the SIM. Kolev et al does not teach determining whether a software module running on the WCD requests supply of power to the SIM by analyzing the data structure. Kolev et al does not teach when any of the bits in the data structure is asserted, supplying power to the SIM.

Deschepper et al teaches asserting respective bits in a data structure [column 3, lines 3-20]. Deschepper et al teaches analyzing the data structure [column 3, lines 21-32].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Kolev et al so that respective bits in a data structure would have been asserted when corresponding software modules running on the WCD requested supply of power to the SIM. It would have been determined whether a software module running on the WCD requested supply of power to the SIM by analyzing the data structure. When any of the bits in the data structure were asserted, power would have been supplied to the SIM.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Kolev et al by the teaching of Deschepper et al because it continues to increase computer system functionality as user needs evolve, modifications to existing components can be prohibitively costly and can limit backward-compatibility. To date, no one has designed a computer system to transmit more than eight bits of information on an eight-bit serial bus [column 3, lines 49-54].

7. Claims 10, 26 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolev et al U.S. Patent No. 6,125,283 as applied to claims 1, 17 and 33 above, and further in view of Eber et al U.S. Patent No. 6,595,414 B1.

As to claims 10, 26 and 42, Kolev et al teaches that the SIM includes an interface circuit that interfaces with the WCD, as discussed above.

Kolev et al does not teach that the interface circuit includes a clock input to the removable user identity module. Kolev et al does not teach that terminating power to the SIM includes terminating power after terminating a clock signal to the clock input.

Eber et al teaches that the interface circuit that includes a clock input [column 8, lines 14-36]. Eber et al teaches terminating power includes terminating power after terminating a clock signal to the clock input [column 8, lines 14-36].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Kolev et al so that the interface circuit would have included a clock input to the removable user identity module. Power would have been terminated to the SIM and included terminating power after terminating a clock signal to the clock input.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Kolev et al by the teaching of Eber et al because it limits the range over which communication is possible between the known data carrier and a write/read station adapted to cooperate with this data carrier [column 2, lines 1-24].

8. Claims 14, 15, 30, 31, 46, 47, 54, 55, 62, 63, 70 and 71 rejected under 35 U.S.C. 103(a) as being unpatentable over Kolev et al U.S. Patent No. 6,125,283 as applied to claims 1, 17, 33, 49, 57 and 65 above, and further in view of Timonen et al U.S. Patent No. 6,741,848 B2.

As to claims 54, 55, 62, 63, 70 and 71, Kolev et al teaches that the user access code is a personal identification number (PIN), as discussed above. Kolev et al teaches that the SIM is one of a removable user identification module (R-UIM) and a GSM SIM, as discussed above.

Kolev et al does not teach that the SIM is a universal subscriber identification module (USIM).

Timonen et al teaches a SIM that is a universal subscriber identification module (USIM) [column 16, lines 14-23].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Kolev et al so that the SIM would have been replaced by a universal identification module (USIM).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Kolev et al by the teaching of Timonen et al because it can be used for user identification and interoperability between mobile communications systems and the GSM system [column 16, lines 14-23].

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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy 
May 12, 2005


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